

**REMARKS**

Claims 1-18 are now present in this application, with new claims 5-18 being presented by the present amendment. Claims 1 and 10 are the sole independent claims remaining in the present application.

**Personal Interview**

Initially, Applicants wish to thank Examiners Fishman and Donovan for the personal interview conducted on January 14, 2004. In the personal interview, Applicants' representative discussed claim 1 of the present application alleging that the element of "the power current connection of the stationery contact tip is in the form of a plate" as set forth in claim 1 was not taught or suggested by any of the prior art of record. Applicants' representative explained that such a plate, supported by at least element 1 of Fig. 1 of the present application, for example, was not taught or suggested by any of the prior art references.

Applicants' representative explained that the reference to Hakamata et al. showed only symmetrical bolts 6 and 7, each acting as conductors for the respective stationery and moving contacts 4 and 5, and thus failed to show a power current connection of stationery contact tip being in the form of a plate. With regard to the Examiner's various attempts to make up for this deficiency utilizing the teachings of Cherry et al. and Stegmuller, Applicants' representative alleged that neither of these references taught such a plate and further alleged that neither of the references provided any motivation for combining their teaching with those of Hakamata et al. At the conclusion of the interview, no agreement was reached, but Applicants' representative did agree to submit additional claims, and the Examiners did agree

to reconsider the various prior art rejections. The Examiners further reserved the right to conduct a further search. At this time, the interview was concluded.

### **Prior Art Rejection**

The Examiner has rejected claims 1-4 under 35 U.S.C. § 103 as being unpatentable over Hakamata et al. in view of Cherry et al. and StegmueLLer. This rejection is respectfully traversed and is further inapplicable to new claims 5-18 for at least the following reasons.

Initially, with regard to independent claim 1, Applicants respectfully submit that none of Hakamata et al., Cherry et al. and StegmueLLer teach or suggest the limitation of “the power current connection of the stationery contact tip is in the form of a plate” as set forth in claim 1, for example. As admitted by the Examiner in both the rejection and the interview, the conductor of the stationery contact 4 is clearly bolt conductor 6 in Hakamata et al., and thus Hakamata et al. fails to teach or suggest such a limitation. The Examiner relies on the teachings of Cherry et al. to make up for such a deficiency, citing planar mounting means 18a and 18b, connected to the cylindrical contacts 14a and 14b of Cherry et al. As indicated at the interview, however, Applicants respectfully submit that this is not a plate, as claimed; and that the Examiner has not provided proper motivation in the form of any evidence as to why one of ordinary skill in the art would be led to combine the planar mounting means 18a and 18b with the teachings of Hakamata et al., and specifically why one of ordinary skill in the art would be led to substitute the planar mounting means of 18a for example, for the bolt conductor 6 of the stationery contact in Hakamata et al.

In order to establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, teaching or suggestion of the desirability of making this

specific combination that was made by the Applicants. The motivation, suggestion or teaching may come explicitly from the statements in the prior art, the knowledge of one of ordinary skill in the art, or in some cases the nature of the problem to be solved. *In re Dembiczak*, 50 USPQ 1614 (Fed. Cir. 1999). Specifically, the Examiner must provide particular findings as to why the two pieces of prior art are combinable. Broad conclusory statements standing alone are not “evidence”. *See Dembiczak*, 50 USPQ at 1617.

In the present case, the Examiner has alleged that the motivation for combining the planar mounting means 18a and 18b of Cherry et al. with the device of Hakamata et al. is that Hakamata et al. in one embodiment discussed in col. 5, lines 45-51 of Hakamata et al. itself, includes a discussion of how the size and weight of an electrode can be reduced in comparison to that of a conventional one. Applicants respectfully submit that this has nothing to do with anything but the teaching of Hakamata et al. itself, as it is merely some embodiment wherein diameters are reduced to reduce size of Hakamata et al. It has nothing to do with why one of ordinary skill in the art would be lead to combine the teachings of Cherry et al. with those of Hakamata et al.

The Examiner additionally points to col. 3, lines 8-15 of Cherry et al., wherein the planar mounting means 18a and 18b are discussed. This again, has nothing to do with why one of ordinary skill in the art would be led to combine the teachings of Cherry et al. with those of Hakamata et al. Hakamata et al. is directed to a vacuum switch including identical bolt conductors 6 and 7 and identical stationery and movable contacts 4 and 5. The identical structure of these electrodes and conductors is discussed in col. 3 of Hakamata et al. and there is no teaching or suggestion of making one of these contact structures different from the other.

Further, Cherry et al. is directed to a completely type of vacuum switch, including an arcing shield preventing disposition of conductive contact material on an insulator body wall of

the switch. The switch is a completely different design than that of Hakamata et al., and thus provides no teaching or suggestion as to why one of ordinary skill in the art would want to employ its planar mounting means and contact structure in a system such as that of Hakamata et al.

Again, it is the Examiner's burden to provide **evidence** as to why one of ordinary skill in the art would have been motivated to select and combine the referenced teachings. Reliance on common knowledge or common sense of a person of ordinary skill in the art, without any specific hint or suggestion of this in a particular reference, is also not a proper standard for reaching the conclusion of obviousness. *See In re Sang Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002).

Here, the Examiner has provided no evidence of motivation. At best, the combination is made using Applicants invention, in hindsight. This is not a proper use of hindsight and cannot be permitted.

In addition, Applicants note that the Examiner also cannot rely on design choice as a reason for combining teachings of various references. This is again not the proper standard for obviousness. If the Examiner is relying on personal knowledge to support a finding of what is known in the art, the Examiner **must provide** an affidavit or declaration setting forth specific factual statements in explanation to support the finding. *See* 37 C.F.R. § 1.104(d)(2); MPP 2144.03(c).

Still further, Applicants respectfully submit that any attempt to alter the structure of Hakamata et al. such that the bolt conductor and stationery contact is made different from the bolt conductor and movable contact, would destroy the teachings of Hakamata et al., which professes identical structures as set forth in col. 3 of the reference. Accordingly, not only is there no motivation to combine the teachings of Cherry et al. with those of Hakamata et al., any

alleged combination would actually destroy the teachings of the reference, **which is an indication of non-obviousness regarding the combination.**

Finally, regarding the StegmueLLer reference, Applicants respectfully submit that even *assuming arguendo* that StegmueLLer could be combined with either one or both of Cherry et al. and Hakamata et al., StegmueLLer would also fail to teach or suggest at least the aforementioned limitation of “the power current connect of the stationery contact tip is in the form of a plate.” Accordingly, for at least these reasons, Applicants respectfully request withdrawal of the Examiner’s rejection and allowance claim 1, and all claims dependent thereon, in connection with the present application.

#### **New Claims**

As set forth above, Applicants note that new claims 5-18 have been added by the present amendment. New claim 5 clarifies that the plate forms a relatively flat top portion of the enclosure. This limitation is clearly not taught or suggested in any of the references, taken either singularly or in combination. There is no teaching or suggestion of any plate which forms a relatively top portion of an enclosure wherein such a plate is a power current connection of the stationery contact tip. New claim 6 sets forth that the plate is proximate to the contact tip, which is supported by at least Fig. 1 of the present application. New claims 7 and 8 set forth that the stationery contact tip is connected to the plate via a centering stub, which is also supported by Fig. 1 of the present application. Finally, new claim 9 sets forth that the plate is directly connected to the stationery contact. This is supported by at least paragraph 13 on page 4 of the present application.

With regard to new claims 10-18, Applicants respectfully submit that at least new independent claim 10 is not taught or suggested by any of the references, taken either singularly or in combination. Specifically, claim 10 sets forth a plate-like power current connection for the stationery contact forming a relatively flat top portion of an enclosure. At least such a limitation is not taught or suggested by any of the references, taken either singularly or in combination.

### CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of claims 1-18 in connection with the present application is earnestly solicited.

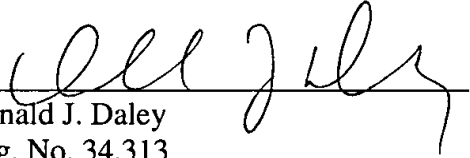
Pursuant to 37 C.F.R. 1.17 and 1.136(a), the Applicant respectfully petitions for a one (1) month extension of time for filing a response in connection with the present application, and the required fee of \$110.00 is attached

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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